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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/758,869	01/16/2004	Nusrallah Jubran	3216.63US01	8013
24113	7590	09/14/2006	EXAMINER	
PATTERSON, THUENTE, SKAAR & CHRISTENSEN, P.A. 4800 IDS CENTER 80 SOUTH 8TH STREET MINNEAPOLIS, MN 55402-2100			DOTE, JANIS L	
			ART UNIT	PAPER NUMBER
			1756	

DATE MAILED: 09/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/758,869

Applicant(s)

JUBRAN ET AL.

Examiner

Janis L. Dote

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-41 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-16 and 26-30, drawn to (Ia) an organophotoreceptor, (Ib) an electrophotographic imaging apparatus, and (Ic) a charge transport compound, classified in class 430, subclass 79, class 399, subclass 159, and class 546, subclass 440+, respectively.
- II. Claims 17-25 drawn to an electrophotographic imaging process, classified in class 430, subclass 117.
- III. Claims 31-41, drawn to (IIIIa) a polymeric charge transport material and (IIIIb) an organophotoreceptor, classified in class 525, subclass 375, and class 430, subclass 80, respectively.

2. The inventions are distinct, each from the other because of the following reasons:

(1) Invention Ia (organophotoreceptor) and invention II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the

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product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case the product as claimed can be used in a materially different process, such as an imaging process comprising the steps of developing an electrostatic latent image formed on the organophotoreceptor of Invention Ia with a toner and fixing the toner image onto the surface of the organophotoreceptor. Such a process does not require transferring the toned image to another substrate as recited in the process of Invention II.

(2) Inventions II and Ib (apparatus) are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the process of Invention II can be practiced by hand. The toner image on a substrate can be formed by the following steps:

- (1) vigorously rubbing the surface of the organophotoreceptor with a soft material, such as a cotton or silk handkerchief;
- (2) light irradiating the charged photoconductor by placing a transparency comprising a light opaque pattern on the charged photoconductor and irradiating light through the transparency with a hand-held light source to form an electrostatic latent

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image; (3) developing the electrostatic latent image by hand sprinkling a toner onto the image-wise exposed latent electrostatic image-bearing member from a can that comprises the toner; and (4) transferring the toner image on the photoconductor to a receiving member by placing the receiving medium, such as a piece of paper, on the toner image on the organophotoreceptor and hand pressing the surface of the receiving medium to the organophotoreceptor with a block, and then manually separating the receiving member with the transferred toner image from the photoconductor.

(3) Invention I(c) (compound) and III(a) (polymer) are related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product, and the species are patentably distinct (MPEP § 806.05(j)). In the instant case, the intermediate product (Ic) is deemed to be useful as a charge transport compound, by itself, in an electroluminescence device or in an organophotoreceptor and the inventions are deemed patentably distinct because there is nothing on this record to show them to be obvious variants.

The following pairs of inventions are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as

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capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06).

(4) Inventions Ic (compound) and II.

In the instant case, the different inventions are not disclosed as capable of being used together and have different designs, modes of operation, and effects. Invention II is drawn to a process that comprises the steps of charging and imagewise exposing an organophotoreceptor to form a charge pattern, developing the charge pattern with a toner to form a toner image, and transferring the toner image to a substrate.

Invention Ic is drawn to a compound. There is no disclosure of using the compound of invention Ic, by itself, in the imaging process of invention II to form an image. In addition, the compound of invention Ic can be used as a charge transport compound in an electroluminescence device.

(5) Invention II and invention IIIa (polymer).

In the instant case, the different inventions are not disclosed as capable of being used together and have different designs, modes of operation, and effects. Invention II is drawn to a process that comprises the steps of charging and imagewise exposing an organophotoreceptor comprising a monomeric charge transport compound to form a charge pattern, developing the charge pattern with a toner to form a toner image, and

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transferring the toner image to a substrate. Invention IIIa is drawn to a polymeric charge transport material. There is no disclosure of using the process of invention II that uses an organophotoreceptor comprising a monomeric charge transport compound with the polymer of invention IIIa. The polymer in invention IIIa can be used in compositions other than an organophotoreceptor, such as a charge transport polymer in an electroluminescence device.

(6) Invention II and invention IIIb (organophotoreceptor).

In the instant case, the different inventions are not disclosed as capable of being used together and have different designs, modes of operation, and effects. There is no disclosure of using the process of invention II that uses an organophotoreceptor comprising a monomeric charge transport compound with the organophotoreceptor of invention IIIb, which comprises a polymeric charge transport material. The organophotoreceptor of invention IIIb can also be used in a materially different process, such as an imaging process comprising the steps of developing an electrostatic latent image formed on the organophotoreceptor of invention IIIb with a toner and fixing the toner image onto the surface of the organophotoreceptor.

(7) Invention Ia (organophotoreceptor) and

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invention IIIb (organophotoreceptor).

In the instant case the different inventions are not disclosed as capable of being used together (each organophotoreceptor is fully functional by itself). The different inventions also have different designs, modes of operation, and effects, because the molecular weight of the charge transport material in invention IIIb photoreceptor is much higher than the molecular weight of the charge transport compound in invention Ia photoreceptor.

(8) Invention Ib (apparatus) and invention IIIb (organophotoreceptor).

In this case, the different inventions are not disclosed as capable of being used together and have different designs, modes of operation, and effects. There is no disclosure of using the apparatus of invention Ib that comprises a organophotoreceptor comprising a monomeric charge transport compound with the organophotoreceptor of invention IIIb, which comprises a polymeric charge transport material. The organophotoreceptor of invention IIIb can be used in a materially different apparatus, such as an apparatus comprising an ionographic device to write an ionographic image on the organophotoreceptor.

(9) Invention Ic (compound) and invention IIIb (organophotoreceptor).

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In the instant case, the different inventions are not disclosed as capable of being used together and have different designs, modes of operation, and effects. There is no disclosure of using the organophotoreceptor of invention IIIb that comprises a polymeric charge transport compound with the monomeric charge transport compound of invention Ic. The compound in invention Ic can be used in compositions other than an organophotoreceptor, such as a charge transport compound in an electroluminescence device.

(10) Invention Ia (organophotoreceptor) and invention IIIa (polymer).

In the instant case, the different inventions are not disclosed as capable of being used together and have different designs, modes of operation, and effects. There is no disclosure of using the organophotoreceptor of invention Ia that comprises a monomeric charge transport compound with the polymeric charge transport material of invention IIIa. The polymeric charge transport in invention IIIa can be used in compositions other than an organophotoreceptor, such as a charge transport compound in an electroluminescence device.

(11) Invention Ib (apparatus) and invention IIIa (polymer).

In this case, the different inventions are not disclosed as capable of being used together and have different designs, modes

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of operation, and effects. There is no disclosure of using the image forming apparatus of invention Ib that comprises a organophotoreceptor comprising a monomeric charge transport compound with the polymeric charge transport material of invention IIIa. The polymeric charge transport in invention IIIa can be used as a charge transport compound in an electroluminescence device.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, and as shown by their different classification, restriction for examination purposes as indicated is proper.

3. Due to the complexity of the restriction requirement, a telephone call was not made to applicant's representative.

4. Applicants are advised that the reply to this restriction requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

5. Applicants are reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be

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amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janis L. Dote whose telephone number is (571) 272-1382. The examiner can normally be reached Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Mark Huff, can be reached on (571) 272-1385. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Any inquiry regarding papers not received regarding this communication or earlier communications should be directed to Supervisory Application Examiner Ms. Claudia Sullivan, whose telephone number is (571) 272-1052.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JLD
Sep. 8, 2006

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PRIMARY EXAMINER
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